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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/857,497
Filing Date	09/08/2000
First Named Inventor	John Selby Unite
Art Unit	3826
Examiner Name	Robert W. Morgan
Attorney Docket Number	JP920000171US1

Total Number of Pages In This Submission: 25

ENCLOSURES *(Check all that apply)*

- [x] Fee Transmittal Form
- [x] Fee Attached
- [ ] Amendment/Reply
  - [ ] After Final
  - [ ] Affidavits/declaration(s)
- [ ] Extension of Time Request
- [ ] Express Abandonment Request
- [ ] Information Disclosure Statement
- [ ] Certified Copy of Priority Document(s)
- [ ] Response to Missing Parts/ Incomplete Application
  - [ ] Response to Missing Parts under 37 CFR 1.52 or 1.53
- [ ] Drawing(s)
- [ ] Licensing-related Papers
- [ ] Petition
- [ ] Petition to Convert to a Provisional Application
- [ ] Power of Attorney, Revocation Change of Correspondence Address
- [ ] Terminal Disclaimer
- [ ] Request for Refund
- [ ] CD, Number of CD(s) _____
- [ ] After Allowance communication to Technology Center (TC)
- [ ] Appeal Communication to Board of Appeals and Interferences
- [x] Appeal Communication to TC **(Appeal Notice, Brief, Reply Brief)**
- [ ] Proprietary Information
- [ ] Status Letter
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Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Anthony V.S. England
Signature	Anthony V S England
Date	10/10/2004

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PTO/SB/17 (10-03)
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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT ($) 330.00

Complete If Known	
Application Number	09/657,497
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METHOD OF PAYMENT *(check all that apply)*

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☑ Deposit Account:

Deposit Account Number: 09-0457

Deposit Account Name: International Business Ma

The Director is authorized to: *(check all that apply)*

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FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description	Fee Paid
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) ($) 0

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

	Extra Claims		Fee from below	Fee Paid
Total Claims		-20** =		X =
Independent Claims		- 3** =		X =
Multiple Dependent				=

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) ($) 0

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for *ex parte* reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	$330.00
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) ($) 330.00

SUBMITTED BY

(Complete *(if applicable)*)

Name (Print/Type)	Anthony V.S. England	Registration No. (Attorney/Agent)	35,129	Telephone	512-477-7165
Signature	Anthony V S England			Date	10/10/2004

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In the United States Patent and Trademark Office

In re the application of: Unite	)		
	)		
Filed: September 8, 2000	)	Group Art Unit:	3626
	)		
For: Build and Operate Program Process Framework and Execution	)	Examiner:	Robert W. Morgan
	)		
Appl. No.: 09/657,497	)		
	)		
Appellant's Docket: JP920000171US1	)		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Dear Sir:

REAL PARTY IN INTEREST

The assignee, International Business Machines Corporation, is the real party in interest.

RELATED APPEALS AND INTERFERENCES

This is the first appeal in the present patent application. There are no other appeals or interferences known to the appellant or its legal representative. International Business Machines Corporation is the sole assignee of the patent application.

STATUS OF CLAIMS

Claims 1, 2, 4-6, 8-11, 13-16, 18, 19 and 21-25 are pending in the application. All claims stand finally rejected and are the subject of this appeal.

Claims 1 through 28 were originally presented in the application. In response to a first Office action (the "First Office Action"), dated November 13, 2003, which rejected all claims on the grounds of prior art, Appellant filed a reply ("Reply A") on February 13, 2004, amending claims 1, 2, 4-6, 8-10, 13, 15, 16, 18, 21, 22, 24, and 25 and canceling claims 3, 7, 12, 17, 20, and 26-28.

The First Office Action also rejected claims 1-28 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention. The 112 rejections were withdrawn by the Examiner based on the changes made by Appellant to the claims in Reply A.

An Office Action (the "Final Office Action"), dated May 5, 2004, finally rejected all pending claims in the present case. Specifically, claims 1, 2, 4, 5, 10, 11, 13, 14, 18, 24, and 25 stand finally rejected under 35 U.S.C. 103(a) as being unpatentable over "A Guide to the Project Management Body of Knowledge" by William R. Duncan (Duncan) in view of U.S. Patent 6,032,124 (Saito). Claims 6, 9, 15, 16, 19, 21, 22, and 23 stand finally rejected under 35 U.S.C. 103(a) as being unpatentable over Duncan in view of U.S. Patent 6,381,610 (Gundewar). Claim 8 stands finally rejected under 35 U.S.C. 103(a) as being unpatentable over Duncan and Gundewar in view of Saito.

The Final Office Action also rejected claims all pending claims under 35 USC 101 because the claimed invention is directed to non-statuatory matter.

Appellant has appealed from the final rejection. Notice of Appeal, received by the USPTO on August 9, 2004.

STATUS OF AMENDMENTS

No amendments were filed subsequent to those submitted in Reply A. The claims in the Claim Appendix herein set out the claims as amended in Reply A.

SUMMARY OF CLAIMED SUBJECT MATTER

The present invention is claimed in the form of a system in independent claims 1 and 6 and a method in independent claims 10, 15, 21, 22, and 24, respectively.

The system of claim 1 concerns a build and operate program that includes "information technology." This term is used in the claims as a convenient way of referring to systems including computer systems or telecommunications equipment or a combination thereof, including both hardware and software, and is a well-understood term. See, e.g., www.foldoc.org definition for "Information Technology" ("Applied computer systems - both hardware and software, and often including networking and telecommunications, usually in the context of a business or other enterprise.") Support for this language is found throughout the specification. See, e.g., page 1, line 27-page 2, line 2 ("A further example of a program is providing technology . . . The program involves building and operating the Olympic Games technology . . . Component projects can, for example, relate to building and operating information technology infrastructure, computer application systems, and telecommunications systems . . . and defining the processes for the collection and dissemination of results information . . ."); page 2, line 30-page 3, line 1 ("An example of a process methodology is the Capability Maturity Model (CMM) . . . The focus of CMM is the build phase of software engineering projects."); page 12, line 20-page 13, line 2 ("To place the size of the program . . . in perspective . . . In terms of computing and telecommunications resources, 80 IBM MQ series servers and 3 IBM S/390 mainframes are deployed. Additionally, there will be 17,000 desktop and portable computing devices in use, as well as numerous other peripheral devices such as printers, validators and displays. An estimated 13 million lines of program code was written to implement all the necessary applications."); page 38, lines 1 and 2 ("Once the . . . framework has been established, it is traversed to execute the program.").

The system, as claimed, includes one or more build processes 20-26, one or more operate processes 30-36, and one or more management processes 40-44. Present application,

FIG's 1-4; page 8, lines 4-9; page 9, lines 10-17, line 30; page 10, line 1. According to the claim, the information technology includes data representing inputs and outputs for processes and a plurality of links 50, 60 70, 80, 90, 100 and 28, 38, and 48 and 110-116, 120-124, 130-134 and 140-144, 150 and 170 that provide connections linking outputs from the build, operate and management processes to inputs of respective other build, operate or management processes. FIG's 1-4; page 8, lines 13-31, page 9, lines 1-5, lines 10-28. The links have exit conditions 162-166 and 182 associated with them that must be satisfied before the link can be traversed from output to input. FIG. 4; page 10, lines 4-12. Selected sets of sequentially-linked processes are assigned to selected project teams, and the sets are designated as respective process streams (Workforce/training, Process, Testing/SW Control & Distribution, Venues/Infrásturcture/Device Configuration & Logistics/Operations, Application Development). FIG. 8; Page 38, lines 12-27. Planning milestones m1-m20 are designated for the outputs having links spanning across two or more of the process streams. FIG. 8; Page 12, lines 5-10, Page 38, lines 7-10, 12-15, 27-28.

The system of claim 6 more specifically concerns a system for a large-scale sporting event. According to the claim, the information technology for the event includes, a set of build processes 20 followed by a set of testing processes 22, operations processes 30 and 32, and game-day processes 34. FIG. 6; Page 13, lines 3-6. The system of claim 6 also includes a set of management processes 40 and 42 related to all of the build, testing, operations, and game-day sets of processes. FIG. 6, page 13, lines 7-10. The event information technology includes data representing inputs and outputs for processes and a plurality of links (Entry Criteria and Exit Criteria). FIG. 9, Page 13, lines 9-11, page 14, line 30, page 15, line 1. Similar to claim 1, the links provide connections linking outputs from build, test, operate, game-day, and management processes to inputs of respective other build, test, operate, game-day, and management processes. FIG. 1; page 8, lines 13-14, lines 17-31. The remainder of claim 6 is like claim 1.

Claim 10 has language similar to claim 1 but is in method form.

Claim 15 is a method form of claim 1 but includes the step of executing the program, including traversing the links from their respective outputs to their respective inputs, wherein

a respective one of the links 150 or 170 is traversed only if the link's exit conditions 162 -166 or 166 and 182 are satisfied. FIG. 4; page 10, lines 1-12.

Claim 21 has language similar to claim 6 but is in method form.

Claim 22 is a method form like claim 15 but includes the step of determining program requirements 205. FIG. 5A, Page 10, lines 20-22.

Claim 24 is a method form like claim 22 but has an additional step regarding executing the program and has additional limitations regarding repeating of steps. Page 38, lines 1-2; page 6, lines 15-20.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1, 2, 4-6, 8-11, 13-16, 18, 19 and 21-25 stand rejected under 35 USC 101 because the claimed invention is directed to non-statuatory matter.

Claims 1, 2, 4, 5, 10, 11, 13, 14, 18, 24, and 25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over "A Guide to the Project Management Body of Knowledge" by William R. Duncan (Duncan) in view of U.S. Patent 6,032,124 (Saito) and of U.S. Patent 6,381,610 (Gundewar).

Claims 6, 9, 15, 16, 19, 21, 22, and 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Duncan in view of U.S. Patent 6,381,610 (Gundewar).

ARGUMENTS

Claims 1, 2, 4 and 5. Solely for the purpose of this Appeal, claims 1, 2, 4 and 5 stand or fall together.

Claim 1, Rejection Under 35 USC 101

Claim 1 stands rejected under 35 USC 101, on grounds that the claimed invention is directed to non-statuatory matter. Appellant respectfully contends the rejection is improper. The Examiner pointed out in the First Office Action that the claims describe an invention that *does* meet the test for statutory subject matter with regard to producing a useful, concrete and tangible result, but not with regard to being within the technological arts. First Office Action, page 17 ("Although the recited process produces a useful, concrete and tangible result . . . the claimed invention, as a whole, is not within the technological arts . . ."). However, the claims were rejected on grounds that "These steps and means do not apply, involve, use or advance

the technological arts since they can be performed in the mind of the user or by use of a pencil and paper. These steps and means only constitute an idea of how to define, [link], and [traverse] processes." First Office Action, pages 16-17.

In response, independent claims 1, 6, 10, 15, 21, 22, 24 and 26 were amended in Reply A amended to particularly point out aspects of the invention within the technological arts in order to meet the test for statutory subject matter and thereby overcome the rejection. However, the rejections were maintained. Final Office Action, pages 16-17.

Appellant respectfully contends claim 1 states an invention in the technological arts. In particular, claim 1 now states that a system for a build and operate program comprises information technology for executing the build and operate program and data structures for processing by the information technology. Reply A specifically pointed out that the term "information technology" in the claim refers to systems including computer systems or telecommunications equipment or a combination thereof, including both hardware and software. And this is a well-understood term in the field of computing technology, as explained in Reply A and in the Summary of Claimed Subject Matter herein above. Thus, the system of claim 1 includes computer systems or telecommunications equipment, or a combination thereof, including both hardware and software.

As the First Office Action acknowledged, the claimed system produces a useful, concrete and tangible result. Appellant contends the claimed systems are not merely an idea of how to define, link, and traverse processes that is performed in the mind of a user or by use of a pencil and paper. Instead, the claimed systems are tangible machines having a particular structure. That is, the claimed system, which is a machine, as explained immediately above, also includes data having a specific structure set out in the claim. A machine having an identified structure in terms of its hardware and software combination is a statutory machine. See MPEP 2106 IV B 2 (a) (discussing statutory machines and In re Lowry, 32 F3d 1579, 1583 (Fed. Cir. 1994)). The claimed computer systems or telecommunications equipment, including both hardware and software, not only produces a useful, concrete and tangible result, but also is a tangible machine having particularly pointed out structures in which included data has inputs, outputs, links and exit conditions. As such, the claimed system is a

statutory machine. For these reasons, Appellant respectfully contends the independent system claim 1 is within the scope of 35 USC 101.

Claim 1, Rejection Under 35 USC 103(a)

Claim 1 also stands rejected under 35 U.S.C. 103(a) as being unpatentable over "A Guide to the Project Management Body of Knowledge" by William R. Duncan (Duncan) in view of U.S. Patent 6,032,124 (Saito) and of U.S. Patent 6,381,610 (Gundewar). Appellant respectfully contends the rejection is improper because i) it does not explain the pertinence of the specific parts of each reference relied upon for rejection of each specific element or step, ii) all the limitations of claim 1 are not taught or suggested by the cited art, and iii) it is improper to combine the teachings of the references that are relied upon for the rejection of claim 1.

According to the present application:

> "Once the program framework has been established, it is traversed to execute the program. An essential function of program management is Schedule Control. When all outputs have been defined, process owners are required to *translate process outputs into a time schedule.* In this way *time dependencies of the completion of each process can be identified.* The use of task activity charts, and the like, is well known, however, *the present invention takes the approach of identifying a subset of all task activities (specifically those that equate to the output of each process) and allocating milestones to process outputs that cut-across defined process streams.* For Schedule control within a project, an activity in the project Schedule is only completed when it satisfies the pre-defined exit criteria. For Schedule control across projects, *milestones* are used. Milestones are groups of outputs produced by a Project Team, that are inputs to processes owned by other Project Teams. Milestones then represent the key dependencies between Project Teams, and are the primary Schedule control tool at a program level.
>
> Consider again Fig. 8, which identifies the following *process streams*:
>
> (i) Workforce/training
> (ii) Process
> (iii) Testing/SW Control & Distribution
> (iv)Venues/Infrastructure/Device Configuration & Logistics/Operations
> (v) Application Development
>
> Process streams are a string of processes typically assigned to a single Project Team. *Where there is a link spanning one or more process streams, a milestone is defined* to represent a dependency between Project Teams. Fig. 8 shows such milestones, indicated as Mn.

> The activities and milestones can be entered into a suitable scheduling tool, such as the Primavera Project Planner where there are assigned start and end dates and owners. On complex programs, the scheduling tool needs to be able to produce multiple views of activities and milestones. For Project Managers it needs to conveniently list the outputs (e.g. deliverables or services) and the resources required to produce them. For Program Managers the tool needs to list the milestones each project team is responsible for, together with the associated deliverables.
>
> There is considerable advantage to forming a connection between significant process outputs and milestones in time. Firstly, attaching deliverables to milestones removes any ambiguity regarding whether a milestone has been achieved. Second, it identifies major cross-team dependencies, which will have a major cross-team impact in the event of schedule slippage. Additionally, being at a higher level than tasks/activities, it is easier for Program Managers to conduct a meaningful review of progress without having to become involved in the inner workings of individual project teams.

Page 38, line 1-page 39, line 13 (emphasis added).

As stated in the passage set out above from the present application, milestones are outputs produced by one project team, and such milestones from the one project team are inputs to processes owned by other project teams. The language of the claim particularly points this out, thereby distinguishing the invention over the cited art. In accordance with this, claim 1 particularly points out that "selected sets of sequentially-linked ones of the processes are assigned to selected project teams." Further, "the sets are designated as respective process streams" and "milestones are designated for ones of the outputs having links spanning across two or more of the process streams." This enables the benefit described at the end of the passage set out above, i.e., "it identifies major cross-team dependencies, which will have a major cross-team impact in the event of schedule slippage."

The rejection relies on teaching by Duncan about a design project having a series of phases from conceptual development through definition and implementation to closure. Duncan, page 13. The Final Office Action contends that this teaches "assigning selected sets of sequentially-linked processes to selected project teams," and that it teaches "the sets are designated as respective process streams," as claimed.

The rejection also relies on a passage in Gundewar, col. 5, lines 57-64, which the Final Office Action states teaches a method for automated project planning with entry and exit criteria that may include milestone, approval, procedure completions and/or design or

production events necessary to enter or exit the particular processes. The Final Office Action contends that the cited passage teaches "milestones are designated for ones of the outputs having links spanning across two or more of the process streams," as claimed in the present case.

Appellant first respectfully contends that the rejection is improper because it does not adequately identify the specific parts and explain the pertinence of the specific parts of each reference relied upon for rejection of each specific element or step. 37 CFR 1.104 (c) (2); MPEP 707 (requirement to set out specific parts of the reference relied upon for the rejection *and an explanation of the pertinence of the specific parts)*. While Appellant gratefully acknowledges that the First Office Action and the Final Office Action *do* point out specific page or figure references relied upon for the rejections, Appellant respectfully contends this falls short of providing Appellant sufficient guidance to fully respond.

Specifically, it is not clear what particular thing in the cited passage of the reference is supposed to be like what particular part of the present claim. For example, is the Final Office Action equating Duncan's "series of phases" to *one* set out of the claimed "*sets* of sequentially-linked processes"? What particular teaching on page 13 of Duncan does the Final Office Action equate to "selected project teams" in claim 1? And what particular act taught on page 13 of Duncan does the Final Office Action equate to the assigning of selected sets of sequentially-linked processes to selected project teams, as claimed in the present case? In the cited passage of Gundewar, if the Final Office Action equates Gundewar's milestones to the claimed milestone in the present case, and equates Gundewar's processes to the claimed process streams in the present case, then what does the Final Office Action equate to the "links spanning across two or more of the process streams" in claim 1 of the present case?

Secondly, Appellant respectfully contends that all the limitations of claim 1 are not taught or suggested by Duncan in view of Saito and Gundewar, and therefore the rejection is improper. MPEP 2143.03 (citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). Specifically, Appellant respectfully contends that the cited teachings of Duncan do not even suggest assigning selected sets of sequentially-linked processes to selected project teams, as claimed in the present case. And Appellant respectfully contends that the cited teachings of Gundewar

do not even suggest "milestones are designated for ones of the outputs having links spanning across two or more of the process streams," as claimed in the present case.

In addition to the above, Appellant wishes to point out that it is important to rely on objective evidence and make specific factual findings with respect to the motivation to combine references. MPEP 2143.01 (citing *In re Lee,* 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002). "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." MPEP 2143.01 (citing *In re Rouffet,* 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998)). Regarding the teachings of the prior art, the teachings must do more than merely show all aspects of the claimed invention were individually known in the art. MPEP 2143.01 (citing *Ex parte Levengood,* 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) and indicating there must be an *objective* reason to combine the teachings of the references). Regarding the nature of the problem to be solved, such motivation might exist in the nature of the problem to be solved if each reference is directed "to precisely the same problem." MPEP 2143.01 (citing In *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, at 1276 (Fed. Cir. 2004)). Regarding the knowledge of persons of ordinary skill in the art, it has been held that without a finding about a "specific understanding or principle within the knowledge of the skilled artisan" that would have provided a motivation combine the teachings, alleged knowledge persons of ordinary skill in the art provided no motivation to combine. MPEP 2143.01 (citing *In re Kotzab,* 217 F.3d 1365, at 1370-1371, (Fed. Cir. 2000)).

Thirdly, Appellant contends the rejection is improper because the asserted motivation for the combination of Duncan and Gundewar is not proper. The Office action contends that one of ordinary skill would have been motivated to combine the asserted teaching by Duncan, as described herein above, with the asserted teachings of Gundewar, as also described herein above, in order to provide a tracking tool for meeting criteria of the processes, citing Gundewar, col. 5, lines 60-64. It appears that the Office action contends the teaching of Gundewar itself provides a motivation to combine the references, since the Office action cites a passage from Gundewar. The Office action appears to be offering, as an objective reason

for the combination, that Gundewar teaches about a tracking tool for meeting criteria of the processes.

Even assuming, merely for the sake of argument, that Duncan teaches "assigning selected sets of sequentially-linked processes to selected project teams," and "the sets are designated as respective process streams," as claimed; and assuming, merely for the sake of argument, that Gundewar teaches "milestones are designated for ones of the outputs having links spanning across two or more of the process streams," as claimed; Appellant contends it does not follow that one of ordinary skill in the art would be motivated by an observation in Gundewar about a tracking tool for meeting criteria of the processes to combine the two purported teachings. The Office action fails to explain how one follows from the other.

For all the above reasons, and particularly because the present invention, as claimed, advantageously provides a previously nonobvious system that enables identifying major cross-team dependencies, which would have a major cross-team impact in the event of schedule slippage, Appellant respectfully contends claim 1 is allowable.

Claims 2, 4 and 5

Appellant respectfully contends that claims 2, 4 and 5 are allowable at least because they depend on claim 1. MPEP 2143.03 ("If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious," citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

Claims 6, 8 and 9. Solely for the purpose of this Appeal, claims 6, 8 and 9 stand or fall together.

Claim 6, Rejection Under 35 USC 101

Claim 6 stands rejected under 35 USC 101, on grounds that the claimed invention is directed to non-statuatory matter. Claim 6 also sets out a system having limitations regarding information technology and data structures, like claim 1. Appellant respectfully contends the rejection is improper for reasons set out above regarding claim 1.

Claim 6, Rejection Under 35 USC 103(a)

Claim 6 also stands rejected under 35 U.S.C. 103(a) as being unpatentable over "A Guide to the Project Management Body of Knowledge" by William R. Duncan (Duncan) in

view of U.S. Patent 6,381,610 (Gundewar). However, claim 6 has all the limitations of claim 1. Consequently, Appellant respectfully contends claim 6 is allowable for the reasons set out above regarding claim 1. Further, claim 6 is all the more allowable because it is more narrowly limited to a sporting event, and further includes a set of game-day processes.

Claims 8 and 9

Appellant respectfully contends that claims 8 and 9 are allowable at least because they depend on claim 6. MPEP 2143.03 ("If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious," citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

Claims 10, 11, 13 and 14. Solely for the purpose of this Appeal, claims 10, 11, 13 and 14 stand or fall together.

Claim 10, Rejection Under 35 USC 101

Claim 10 stands rejected under 35 USC 101, on grounds that the claimed invention is directed to non-statuatory matter. Appellant respectfully contends the rejection is improper.

A claim for a computer-related process is statutory if it results in a physical transformation outside the computer for which a practical application in the technological arts is disclosed. See MPEP 2106 IV B 2 (b) (discussing statutory processes and Alappat, 33 F.3d 1526, 1543 (Fed. Cir. 1994) (in banc). The inputs, outputs, links and exit conditions of claim 10 are not explicitly claimed as being *in* data that is *included* in the computer systems or telecommunications equipment, as is the case with claim 1, for example. But the method of claim 10 includes executing a build process, which includes building information technology. Since this means building a computer system or telecommunication equipment, or a combination thereof, including both hardware and software, the claimed step therefore requires putting together computer system or telecommunication hardware and developing software. Thus, claim 10 results in a physical transformation of computer system or telecommunications equipment that is being built, which occurs outside a computer system. "A claimed process is clearly statutory if it results in a physical transformation outside the computer . . ." MPEP 2106 IV B 2 (b) (immediately prior to discussing specific examples of

safe harbors in which such transformations occur). Accordingly, Appellant contends claim 10 is to a statutory process.

Claim 10, Rejection Under 35 USC 103(a)

Claim 10 also stands rejected under 35 U.S.C. 103(a) on the same grounds as claim 1. Claim 10 sets out limitations that are like claim 1 insofar as the prior art rejections are concerned, except that claim 10 is for a method form of the invention, and except that the claimed inputs, outputs, links and exit conditions are not explicitly stated as being in data that is included in computer systems or telecommunications equipment. Aside from this structural aspect, the process limitations regarding inputs, outputs, links, exit conditions and their interrelation are as set out in claim 1. Appellant therefore respectfully contends the rejection under 35 U.S.C. 103(a) is improper for reasons set out above regarding the rejection under 35 U.S.C. 103(a) of claim 1, and that the invention of claim 10 is patentably distinct.

For all the above reasons, and particularly because the present invention, as claimed, advantageously provides a previously nonobvious process that enables identifying major cross-team dependencies, which would have a major cross-team impact in the event of schedule slippage, Appellant respectfully contends claim 10 is allowable.

Claims 11, 13 and 14

Appellant respectfully contends that claims 11, 13 and 14 are allowable at least because they depend on claim 10. MPEP 2143.03 ("If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious," citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

Claims 15, 16, 18 and 19. Solely for the purpose of this Appeal, claims 15, 16, 18 and 19 stand or fall together.

Claim 15, Rejection Under 35 USC 101

Claim 15 stands rejected under 35 USC 101, on grounds that the claimed invention is directed to non-statuatory matter. Claim 15 has limitations regarding information technology and data structures like those claim 10. Appellant respectfully contends the rejection is improper for reasons set out above regarding claim 10.

Claim 15, Rejection Under 35 USC 103(a)

Claim 15 also stands rejected under 35 U.S.C. 103(a) on the same grounds as claim 6. Claim 15 sets out limitations that are like claim 1 insofar as the prior art rejections are concerned, except for the following: i) claim 15 is for a method form of the invention, ii) the claimed inputs, outputs, links and exit conditions of claim 15 are not explicitly claimed as being in data that is included in computer systems or telecommunications equipment, and iii) claim 15 has an additional step regarding executing the program. Aside from the structural aspect of ii), the process limitations regarding inputs, outputs, links, exit conditions and their interrelation are as set out in claim 1. Appellant therefore respectfully contends the rejection under 35 U.S.C. 103(a) is improper for reasons set out above regarding the rejection under 35 U.S.C. 103(a) of claim 1, and that the invention of claim 15 is patentably distinct.

Claims 16, 18 and 19. Claims 16, 18 and 19 are allowable at least because they depend on claim 15. MPEP 2143.03 ("If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious," citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

Claim 21. Claim 21 stands or falls alone.

Claim 21, Rejection Under 35 USC 101

Claim 21 stands rejected under 35 USC 101, on grounds that the claimed invention is directed to non-statuatory matter. Claim 21 has limitations regarding information technology and data structures like those of claim 10. Appellant respectfully contends the rejection is improper for reasons set out above regarding claim 10.

Claim 21, Rejection Under 35 USC 103(a)

Claim 21 also stands rejected under 35 U.S.C. 103(a) on the same grounds as claim 6. Claim 21 sets out limitations that are like claim 6 insofar as the prior art rejections are concerned, except for the following: i) claim 21 is for a method form of the invention, and ii) the inputs, outputs, links and exit conditions of claim 21 are not explicitly claimed as being in data that is included in computer systems or telecommunications equipment. Aside from this structural aspect of ii), the process limitations regarding inputs, outputs, links, exit conditions and their interrelation are as set out in claim 6. Appellant therefore respectfully contends the

rejection under 35 U.S.C. 103(a) is improper for reasons set out above regarding the rejection under 35 U.S.C. 103(a) of claim 6, and that the invention of claim 21 is patentably distinct.

Claim 22 and 23. Solely for the purpose of this Appeal, claims 22 and 23 stand or fall together.

Claim 22, Rejection Under 35 USC 101

Claim 22 stands rejected under 35 USC 101, on grounds that the claimed invention is directed to non-statuatory matter. Claim 22 has limitations regarding information technology and data structures like those claim 10. Appellant respectfully contends the rejection is improper for reasons set out above regarding claim 10.

Claim 22, Rejection Under 35 USC 103(a)

Claim 22 also stands rejected under 35 U.S.C. 103(a) on the same grounds as claim 15. Claim 22 sets out limitations that are like claim 15 insofar as the prior art rejections are concerned, except claim 22 includes a step of determining program requirements. Appellant therefore respectfully contends the rejection under 35 U.S.C. 103(a) is improper for reasons set out above regarding the rejection under 35 U.S.C. 103(a) of claim 15, and that the invention of claim 21 is patentably distinct.

Claim 23. Claim 23 is allowable at least because it depends on claim 22. MPEP 2143.03 ("If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious," citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

Claims 24 and 25. Solely for the purpose of this Appeal, claims 24 and 25 stand or fall together.

Claim 24, Rejection Under 35 USC 101

Claim 24 stands rejected under 35 USC 101, on grounds that the claimed invention is directed to non-statuatory matter. Claim 24 has limitations regarding information technology and data structures like those claim 10. Appellant respectfully contends the rejection is improper for reasons set out above regarding claim 10.

Claim 24, Rejection Under 35 USC 103(a)

Claim 24 also stands rejected under 35 U.S.C. 103(a) on the same grounds as claim 10. Claim 24 sets out limitations that are like claim 22 insofar as the prior art rejections are concerned, except that claim 24 has an additional step regarding executing the program and has additional limitations regarding iterative repeating of steps. Appellant therefore respectfully contends the rejection under 35 U.S.C. 103(a) is improper for reasons set out above regarding the rejection under 35 U.S.C. 103(a) of claim 22, and that the invention of claim 24 is patentably distinct.

Claim 25. Claim 25 is allowable at least because it depends on claim 22. MPEP 2143.03 ("If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious," citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

REQUEST FOR ACTION

Based on the above arguments, Appellant requests that claims 1, 2, 4-6, 8-11, 13-16, 18, 19 and 21-25 of the present application be allowed and the application promptly passed to issuance.

Respectfully submitted,

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Attachment: Claims Appendix

IN THE CLAIMS

Please amend the claims as set out below:

1. (previously presented) A system for a build and operate program, comprising:

information technology for the build and operate program, wherein the program includes:

one or more build processes;

one or more operate processes; and

one or more management processes; and

wherein the information technology includes data representing i) inputs and outputs for ones of said processes and ii) a plurality of links associated with respective ones of the inputs and outputs, wherein the links provide connections linking outputs from ones of said build, operate and management processes to inputs of respective other ones of the build, operate or management processes;

wherein such a link has exit conditions associated with the link and the exit conditions for the link must be satisfied before the link can be traversed from output to input;

wherein selected sets of sequentially-linked ones of the processes are assigned to selected project teams and the sets are designated as respective process streams; and

wherein planning milestones are designated for ones of the outputs having links spanning across two or more of the process streams.

2. (previously presented) The system of claim 1, wherein said build processes precede said operate processes, with an overlapping boundary therebetween, such that some operate processes are able to be executed before all build processes are executed.

3. (canceled)

4. (previously presented) The system of claim 3, wherein each management process is linked only to either a build process or an operate process.

5. (previously presented) The system of claim 1, wherein said exit conditions represent deliverable products or services that have been agreed to be provided.

6. (previously presented) A system for a large-scale sporting event, comprising:

information technology for the event, wherein the event includes:

a set of build processes generally followed by a set of testing processes, generally followed by a set of operations processes, generally followed by a set of game-day processes;

a set of management processes related to all of said build, testing, operations, and game-day sets of processes; and

wherein the information technology includes data representing i) inputs and outputs for ones of said processes and ii) a plurality of links, wherein the links provide connections linking outputs from ones of said build, test, operate, game-day, and management processes to inputs of respective other ones of the build, test, operate, game-day, and management processes;

wherein such a link has exit conditions associated with the link and the exit conditions for the link must be satisfied before the link can be traversed from output to input;

wherein sets of selected, sequentially-linked ones of the processes are assigned to selected project teams and the sets are designated as respective process streams; and

wherein planning milestones are designated for ones of the outputs having links spanning across two or more of the process streams.

7. (canceled)

8. (previously presented) The system of claim 6, wherein each management process is linked only to either a build process or an operate process.

9. (previously presented) The system of claim 6, wherein said exit conditions represent deliverable products or service levels that have been agreed to be provided.

10. (previously presented) A method for establishing a build and operate program, wherein executing the program includes building and operating information technology, the method comprising the steps of:

defining one or more build processes, wherein executing such a build process includes building information technology;

defining one or more operate processes, wherein executing such an operate process includes operating information technology;

defining one or more management processes, wherein the build, operate and management processes have respective inputs and outputs;

forming a plurality of links associated with respective ones of the inputs and outputs, wherein the links provide connections linking the outputs from ones of said build, operate, and management processes to the inputs of respective other ones of the build, operate, or management processes;

associating exit conditions with the respective links, wherein the exit condition for a respective one of the links must be satisfied before the link can be traversed from output to input;

assigning selected sets of sequentially-linked ones of the processes to selected project teams and designating the sets as respective process streams; and

designating planning milestones for ones of the outputs having links spanning across two or more of the process streams.

11. (original) The method of claim 10, wherein said build processes precede said operate processes, with an overlapping boundary therebetween such that some operate processes are able to be executed before all build processes are executed.

12. (canceled)

13. (previously presented) The method of claim 11, wherein each management process is linked only to either a build process or an operate process.

14. (original) The method of claim 10, wherein said exit conditions represent deliverable products or service levels that have been agreed to be provided.

15. (previously presented) A method for executing a build and operate program, wherein executing the program includes building and operating information technology. the method comprising the steps of:

defining one or more build processes, wherein executing such a build process includes building information technology;

defining one or more operate processes, wherein executing such an operate process includes operating information technology;

defining one or more management processes, wherein the build, operate and management processes have respective inputs and outputs;

forming a plurality of links, wherein the links provide connections linking outputs from ones of said build, operate, and management processes to inputs of respective other ones of the build, operate, or management processes, such a link being associated with at least one of the outputs and one of the inputs;

associating exit conditions with the respective links;

assigning selected sets of sequentially-linked ones of the processes to selected project teams and designating the sets as respective process streams; and

designating planning milestones for ones of the outputs having links spanning across two or more of the process streams; and

executing the program, including traversing the links from their respective outputs to their respective inputs, wherein a respective one of the links is traversed only if the link's exit conditions are satisfied.

16. (previously presented) The method of claim 15, wherein said build processes precede said operate processes, with an overlapping boundary therebetween such that some operate processes are able to be executed before all build processes are executed.

17. (canceled)

18. (previously presented) The method of claim 16, wherein each management process is linked only to either a build process or an operate process.

APPENDIX "AA" CLAIMS

19. (original) The method of claim 15, wherein said exit conditions represent deliverable products or service levels that have been agreed to be provided.

20. (canceled)

21. (previously presented) A method for executing a large-scale sporting event, comprising the steps of:

defining a set of build processes generally followed by a set of testing processes, generally followed by a set of operations processes, generally followed by a set of game-day processes, wherein executing such a build process includes building information technology and executing such an operate process includes operating information technology;

defining a set of management processes related to all of said build, testing, operations, and game-day processes, wherein the build, testing, operations, management and game-day processes have respective inputs and outputs;

forming a plurality of links associated with respective ones of the inputs and outputs, wherein the links provide connections linking outputs from ones of said build, test, operate, game-day, and management processes to the inputs of respective other ones of the build, test, operate, game-day, and management processes; and

associating exit conditions with the respective links, wherein the exit condition for a respective one of the links must be satisfied before the link can be traversed from output to input;

assigning selected sets of sequentially-linked ones of the processes to selected project teams and designating the sets as respective process streams; and

designating planning milestones for ones of the outputs having links spanning across two or more of the process streams.

22. (previously presented) A method for executing a build and operate program, comprising the steps of:

determining program requirements;

defining, responsive to said requirements, build, operate, and management processes, and related links therebetween, wherein the build, operate and management processes have respective inputs and outputs , wherein executing such a build process includes building

information technology and executing such an operate process includes operating information technology;

associating exit conditions with the respective links, wherein such a link between respective ones of processes is only traversable if exit conditions associated with the link are satisfied;

assigning selected sets of sequentially-linked ones of the processes to selected project teams and designating the sets as respective process streams; and

designating planning milestones for ones of the outputs having links spanning across two or more of the process streams; and

executing the processes, including traversing said links over time.

23. (original) The method of claim 22, wherein said requirements include deliverable products and service levels.

24. (previously presented) A method for executing a build and operate program comprising the steps of:

a) determining program requirements;

b) defining, responsive to said requirements, build, operate, and management processes, and related links therebetween, wherein the build, operate and management processes have respective inputs and outputs, wherein executing such a build process includes building information technology and executing such a operate process includes operating information technology;

c) determining what requirements should be met to perform a certain one or more of the processes;

d) defining exit criteria for one or more of the processes immediately preceding the certain one or more processes for which requirements were determined in step c), wherein said exit criteria for such a processes must be satisfied before traversing any such link defined in step b) from the process to another one of the processes;

e) repeating steps c) and d), in a next iteration thereof, for one or more of the processes immediately preceding the one or more of the processes for which the requirements were determined in the previous iteration of step c), wherein an initial one of the iterations of step c) begins with an ultimate one of the operate processes;

APPENDIX "AA" CLAIMS

assigning selected sets of sequentially-linked ones of the processes to selected project teams and designating the sets as respective process streams; and

designating planning milestones for ones of the outputs having links spanning across two or more of the process streams; and

f) executing the processes, including traversing said links over time.

25. (original) The method of claim 24, wherein said requirements include deliverable products and service levels.

26 - 28. (canceled)